

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Marc BOERNER et al.

Serial No.: 10/533,944

Group Art Unit: 4134

Filed: October 10, 2003

Examiner: Nguyen, Thuy-AI

Title: SEMICONDUCTOR SURFACE TREATMENT AND MIXTURE USED THEREIN

PETITION TO THE DIRECTOR UNDER 37 CFR 1.181

Mail Stop : PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Action Requested

The Office Action of 29 April 2008 was improperly made final. Withdrawal of the finality of the Office Action of 29 April 2008 is respectfully requested.

Facts and Reasons

On 11 January 2008 Applicants filed an Amendment in response to the Office Action of 211 October 2007. Thereafter, on 29 April 2008, the Examiner issued a second Office Action on the merits that was made **Final**. On page 5 of the Office Action, the Examiner alleges that Applicants' amendments necessitated the new ground of rejection. This is not correct. As noted in the response filed January 2008, the claims were amended to correct typographical errors, to remove trade names, clarify and to place them in a format more customary to US patent practice. The new rejections were necessitated only by the inapplicability of the previously cited prior art, not any action by Applicant. All previous rejections were based on Martyak et al. (US. 2004/0092106) which is not effective prior art against the instant application. On page 5 of the

Office Action the Examiner provides no response to Applicants' previous arguments merely stating that they are moot in light of new grounds of rejection. Furthermore, the new grounds of rejection are under a different section of the statute, i.e., §102 versus §103, and thus raise new issues not previously addressed.

The new grounds for rejection were clearly not necessitated by Applicant's amendments. As such, the finality of the Office Action must be withdrawn.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Attorney Docket No.: AKA-0284

Date: **28 November 2007**

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